

Remarks

In view of the following remarks, Applicant respectfully requests reconsideration and allowance of the subject application. Over the Applicant's traverse, claims 15-62 and 67-83 have been subject to a restriction and have been withdrawn from further consideration as being drawn to non-elected inventions. In the interest of expediting allowance of the subject application, claims 15-62 and 67-83 are canceled herein without prejudice. Claims 1-14 and 63-65 remain pending. No claims are amended.

Statement of Substance of Examiner Interview dated 2/6/08

Applicant would like to sincerely thank Examiner Le Nguyen for her time in discussing this application over the phone on 2/6/08 with Applicant's Attorney, Daniel McGinnity.

During this interview, the §102 and §103 rejections based on Larcheveque were briefly discussed. Applicant's attorney noted that, in making out these rejections on p. 4 and p. 7 of the Office Action, the Examiner failed to provide a Publication No., Patent No., or other citation to identify the named reference Larcheveque. Accordingly, the Applicant was unable to definitively determine what reference was intended to be cited. The Examiner clarified the intended reference as U.S. Patent Publication No. 2004/0226002 to Larcheveque et al. Applicant's attorney then discussed patentability arguments with respect to Larcheveque et al. No agreement was reached.

For at least the reasons that follow, the Applicant submits that all of the pending claims are in condition for allowance. If any issues remain that would

prevent the allowance of the application, Applicant requests that the Examiner contact the undersigned attorney to resolve the issues.

Objections to the Drawings and Specification

5 The drawings are objected to as failing to comply with 37 CFR 1.84 (p)(5) because they do not include reference sign 1116 mentioned in the description in lines 5-6 of section [0102].

10 The specification is objected to as failing to comply with 37 CFR 1.84(p)(5) because the drawings include the following reference character(s) not mentioned in the description: 208 of fig.2; 414 of fig.4; 606 of fig.6b; 704 of fig.7b; 1000 of fig. 10; 1140 and 1142 of fig. 11; 1212 and 1216 of fig. 12a; and 1216 and 1222 of fig. 12b.

15 Appropriate correction has been made herein as reflected in the foregoing Amendments to the Specification. In addition, replacement drawings sheets for sheets 1-14 are submitted with this paper, to correct the title block in sheets 1-14 and the reference numbers in FIG. 2. Accordingly, the rejections have been obviated.

35 U.S.C. §112 Rejections

20 Claims 1-14 and 63-65 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner

alleges that the term “without user interaction” renders the claims indefinite.
Applicant respectfully disagrees.

The features of “discovering, without user interaction, the solution” and
“deploying, without user interaction, the solution”, as in claim 1, recite with clarity
5 discovering and deploying of a solution that occurs without user interaction.
These features are readily understood by one of skill in the art. Further, the
Examiner is directed to Specification at least at paragraphs [0028] and [108]-[112]
These portions describe examples of discovering and deploying a solution for a
data file that occurs without user interaction. For example, discovering and
10 deploying a solution may occur without an affirmative selection of the solution by
a user and/or without a user knowing that a solution exists. Accordingly, the
claims as presently recited particularly point out and distinctly claim the subject
matter, and satisfy the requirements of 35 U.S.C. §112, second paragraph. For at
least these reasons, withdrawal of the rejections is respectfully requested.

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35 U.S.C. §102 Rejections & 35 U.S.C. §103 Rejections

Claims 1-3, 5, 7-9, 11, 12, 14, and 63-64 stand rejected under
35 U.S.C. §102(e) as anticipated by Larcheveque et al. (“Larcheveque”).

Claims 4, 6, 10, 13, and 65 stand rejected under 35 U.S.C. § 103(a) as being
20 unpatentable over Larcheveque. Applicant respectfully disagrees.

In making out these rejections on p. 4 and p. 7 of the Office Action, the Examiner relies upon Larcheveque et al, which was clarified in the interview as U.S. Patent Publication No. 2004/0226002.

Applicant asserts that a *prima facie* case has not been established for at least the following reasons. In particular, U.S. Patent Publication No. 2004/0226002 to Larcheveque et al. (1) does not appear to be prior art (2) is insufficient to anticipate the claims under §102, and (3) may be disqualified as prior art with respect under §103 rejections. Specifically:

(1) U.S. Patent Publication No. 2004/0226002 has a filing date of 11/25/2003, which is after the filing date 6/27/2003 of the present application. Accordingly, U.S. Patent Publication No. 2004/0226002 is not a prior art reference with respect to the present application.

(2) U.S. Patent Publication No. 2004/0226002 and the present application are commonly assigned to Microsoft Corporation. Accordingly, with respect to the §103 rejections, Applicant's attorney submits that U.S. Patent Publication No. 2004/0226002 may be disqualified as prior art in accordance with 35 U.S.C. 103(c). 35 U.S.C. §103(c)(1) states: "Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person." *See MPEP §2146.*

Therefore, Applicant asserts that U.S. Patent Publication No. 2004/0226002 to Larcheveque et al. is disqualified as a prior art reference against the subject Application under 35 U.S.C. §103(c)(1) as owned by or subject to an obligation of assignment to Microsoft Corporation, the assignee of the subject Application. Accordingly, withdrawal of the Larcheveque reference is respectfully requested.

(3) After careful review of U.S. Patent Publication No. 2004/0226002, it is noted that U.S. Patent Publication No. 2004/0226002 is entirely silent as to numerous recited features of claims 1 and 63. For example, Claim 1 recites in part:

- discovering, without user interaction, the solution
- deploying, without user interaction, the solution
- wherein the solution defines the availability of one or more actions to the user when entering the data into each said operable field of the electronic form

Claim 63 includes similar features in varying terms and scope. While U.S. Patent Publication No. 2004/0226002 does mention a solution, it does not describe deploying or discovering of a solution. Further, U.S. Patent Publication No. 2004/0226002 makes no mention of a solution defining “the availability of one or more actions to the user when entering the data into each said operable field of the electronic form.” Thus, with respect to the §102 rejections, U.S. Patent Publication No. 2004/0226002 fails to provide at least the above noted features of the claims as presently recited. Accordingly, claims 1 and 63 and their respective dependent claims are not anticipated by U.S. Patent Publication No. 2004/0226002.

For the foregoing reasons U.S. Patent Publication No. 2004/0226002, (1) does not appear to be prior art (2) is insufficient to anticipate the claims under §102, and (3) would be disqualified as prior art with respect to §103 rejections. Accordingly, the interests of furthering prosecution would not be served by maintenance of the reference in the next office action. To the extent that U.S. Patent Publication No. 2004/0226002 has been relied upon, withdrawal of the reference is respectfully requested.

For at least these reasons, a *prima facie* case of anticipation or obviousness has not been established, and claims 1-14 and 63-65 are allowable. It is noted that because the rejections of the claims have not been properly made out in the present Office Action, finality of the next office action would be premature.

Conclusion

The Application is in condition for allowance and the Applicant respectfully requests reconsideration and issuance of the present application. Should any issue remain that prevents immediate issuance of the application, the Examiner is requested to contact the undersigned attorney to discuss the unresolved issue.

Respectfully submitted,

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